

REMARKS

Claims 1-16 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner rejected claims 1–16 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement; rejected claim 1 under 35 U.S.C. §112, second paragraph, as being indefinite; rejected claims 1 and 8 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,530,628 to Ngai (hereinafter referred to as “the Ngai ‘628 patent”); and rejected claims 2-6 and 9-16 under 35 U.S.C. §103(a) as being anticipated by the Ngai ‘628 patent.

By this Response and Amendment, claims 1 and 8 have been amended to clarify the claimed subject matter intended by the Applicant. Claim 13 has been amended to correct a typographical error only. Claims 15 and 16 have been amended to maintain consistency in claim terminology only. In this regard, Applicant notes that the amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

It is respectfully submitted that the above amendments do not introduce any new matter to this application within the meaning of 35 U.S.C. §132.

Interview Summary

Applicant gratefully appreciates the courtesies extended to Applicant’s representative during the telephonic Interview conducted on April 21, 2008. Discussion focused on independent claims 1 and 8. The Applicant is grateful for the opportunity to explain Applicant’s claimed subject matter, discuss and come to some agreement regarding claim amendment language proposed to overcome the Examiner’s 35 U.S.C. §112, first paragraph, rejections.

Claim Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1-16 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Response

By this Response and Amendment, claims 1 and 8 have been amended and, as amended, the rejections thereto are respectfully traversed. Applicant has further clarified the structure elements used in the claimed device and method.

Accordingly, Applicant submits that claims 1 and 8 are enabling and submit that claims 2-7 and 11-15, and 9, 10 and 16 which depend from independent claims 1 and 8, respectively, are also then enabling and request indication of such. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

Claim Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejected claim 1 under 35 U.S.C. §112, second paragraph, as being indefinite.

Response

By this Response and Amendment, claim 1 has been amended and, as amended, the rejection thereto is respectfully traversed. Applicant has further clarified the structure elements used in the claimed device.

Applicant submits that claim 1 is definite and distinctly claims the Applicant's subject matter and request indication of such. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection.

Claim Rejections under 35 U.S.C. § 102(b)

The Examiner rejected claims 1 and 8 under 35 U.S.C. §102(b) as being anticipated by the Ngai '628 patent.

Response

By this Response and Amendment, claims 1 and 8 have been amended and, as amended, the rejections thereto are respectfully traversed as all of the features of the presently claimed subject matter are not disclosed, taught or suggested by the cited prior art of record.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every

element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Overview

Applicant's amended independent claim 1 recites: "Device for illuminating a line surface (3) having a light source (1, 9) designed to have a linearly arranged illumination and having at least one linearly formed optical element (2, 10), wherein in a region of said optical elements (2, 10) of said light source (1, 9) said device comprises at least one diaphragm (6) having a shape which effects a variable numerical aperture along the diaphragm at locations corresponding to a projection of the light through the light through the diaphragm in a direction of the line to decrease a light intensity associated with an imaging lens to substantially reduce vignetting (decrease in light intensity at an end of the line)."

Applicant's amended independent claim 8 recites: "Method for providing illumination of a surface, the method comprising: providing a linearly arranged light source, including at least one optical element; providing at least one diaphragm having a shape, in the region of said optical elements of said light source, which effects a variable numerical aperture along the diaphragm at locations corresponding to a projection of the light through the light through the diaphragm in a longitudinal direction, in a manner calculated to substantially reduce vignetting produced by a natural decrease in light intensity associated with an imaging lens."

The Ngai '628 patent is drawn to a task light that reduces the glare in an enclosed work area, particularly in a furniture system that has an upper shelf housing the light source. The system of the Ngai '628 patent uses a light source **95** whose light is reflected off a reflector **97** in a gently curved manner to distribute the light more evenly in a plane perpendicular to the light source's axis (linear). See FIGS. 4-5 and col. 8, lines 13-33. FIGS. 5-8 describe a prismatic grating **150, 163** that more "evenly" distributes the light in the near field along the plane perpendicular to the light source's axis.

Rejection of claims 1 and 8

The Examiner asserts in the outstanding Office Action (page 3) that “[r]egarding claims 1 and 8, Ngai (‘628) discloses a linear light source 141, a linearly formed optical element 139, and at least on *[sic]* diaphragm 157. Regarding claim 8, since the claim, claims the method of illuminating a surface the limitation of claimed *[sic]* are met by Ngai since each limitation is met by the prior art.”

However, the Examiner has not addressed and completely ignored several significant features of Applicant’s claimed subject matter. He has not at all discussed whether the asserted diaphragm of the Ngai ‘628 patent has a shape “...which effects a variable numerical aperture... in a direction of the line to decrease a light intensity associated with an imaging lens to substantially reduce vignetting...” as recited in Applicant’s independent claims 1 and 8 even prior to the present amendment (wherein ‘shape’ was formerly referred to as ‘characteristic,’ a minor amendment that certainly does not affect the ability of the Examiner to address such features). ‘Vignetting’ is a term not at all used in the Examiner’s prior art rejections. Indeed, the Examiner admits (on page 4 of the Office Action), while discussing the 35 U.S.C. §103(a) rejections, that “Ngai discloses all the limitations of the claims but does not disclose the variable numerical aperture as claimed or the types of finished *[sic]* claimed.” This self-contradicting statement further underscores the incompleteness of the present 35 U.S.C. §102(b) rejections, as if “Ngai... does not disclose the variable numerical aperture as claimed” as the Examiner admits, then the requirements of a proper 35 U.S.C. §102(b) rejection cannot be met.

The Applicant respectfully submits that the Ngai ‘628 patent fails to disclose not only the features discussed above but even basically, a diaphragm as in the presently claimed subject matter. The Ngai ‘628 patent does not at all disclose a diaphragm, much less one with features as in the presently claimed subject matter, and presents only a simple frame for a planar lens portion. No s is given by the Ngai ‘628 patent of how to solve the known art problem of vignetting of a line light by a diaphragm with a convex border line, much less the solution presented by the “variable numeric aperture along the light line” recited at least in Applicant’s independent claims.

In all of the Ngai ‘628 patent’s embodiments, there is no disclosure or suggestion relating to a diaphragm capable of affecting the illumination in the direction of the line of the light source. Nor is there any disclosure regarding reducing vignetting at the end of the line or with

the longitudinal direction. In fact, all of the Ngai '628 patent's embodiments deal specifically with a non-line direction (e.g., perpendicular plane to a line light). Thus, the Ngai '628 patent does not disclose or suggest all of the features in Applicant's independent claims.

Therefore, for at least the above reasons, Applicant respectfully submits that the Ngai '628 patent does not disclose, teach, or suggest the novel and patentable features of a "[d]evice for illuminating a line surface (3) having a light source (1, 9) designed to have a linearly arranged illumination and having at least one linearly formed optical element (2, 10), wherein in a region of said optical elements (2, 10) of said light source (1, 9) said device comprises at least one diaphragm (6) having a shape which effects a variable numerical aperture along the diaphragm at locations corresponding to a projection of the light through the light through the diaphragm in a direction of the line to decrease a light intensity associated with an imaging lens to substantially reduce vignetting (decrease in light intensity at an end of the line)" as recited in amended claim 1 of the instant application.

Accordingly, Applicant submits that amended claim 1 is patentable over the prior art of record, and submit that amended claim 8 directed to a method reciting similar features, is also then patentable over the prior art of record and request indication of such.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 2-6 and 9-16 under 35 U.S.C. §103(a) as being anticipated by the Ngai '628 patent.

Response

Applicant respectfully traverses the rejections since all of the features of the presently claimed subject matter are not disclosed by the cited reference.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

As discussed above, Applicant respectfully submits that the Ngai '628 patent fails to disclose the claimed subject matter in accordance with Applicant's amended independent claims 1 and 8 and further, does not suggest a teaching or motivation to reach such subject matter as claimed in the instant application.

Applicant further respectfully submits that the Examiner's assertion that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to use a variable numerical aperture having the compensating [sic] according to claims 2 and 9 or the type spectral transmission finish or non spectral finish as cited in claims 2-6, 10-16 since it has been held within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design preference and the applicant has not discussed the criticality of the claimed elements" is insufficient to provide a motivation under the obviousness standard. Obviousness must be considered in view of the technical problem to be solved and in view of the cited art of record considering such (a) problem(s). Further, the technical skill of one having ordinary skill in the art is relevant in such (a) solution(s) for design variation(s) of an embodiment only.

MPEP 2144.07 "*Art Recognized Suitability for an Intended Purpose*" discusses "*In re Leshin* 125 USPQ 416 cited by the Examiner (page 4 of the instant Office Action) in very limited form but also discusses: "*Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988) (Claimed agricultural bagging machine, which differed from a prior art machine only in that the brake means were hydraulically operated rather than mechanically operated, was held to be obvious over the prior art machine in view of references which disclosed hydraulic brakes for performing the same function, albeit in a different environment.)" in which obviousness was held in view of *references* disclosing materials for performing the claimed function, thereby providing explicit support for a technical solution to a technical problem. Thus, Applicant requests the Examiner to provide explicit evidence or basis for his asserted reasoning of obviousness, particularly as the Ngai '628 patent does not even discuss a diaphragm as claimed and substantially disclosed by the Applicant nor admittedly the numerical aperture and other features of Applicant's claims. Applicant assumes that the Examiner's statement is tantamount to official notice and therefore the above request is supported by MPEP 2144.03(B) "*Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable*"

states: "...If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately traverse the rejection in the next reply after the Office action in which the common knowledge statement was made."

Even if the Examiner's statement that "it has been held within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design preference and the applicant has not discussed the criticality of the claimed elements" is assumed true, such a statement does not address "*a variable numerical aperture*" as discussed in claims 2, 9 and 10, much less the *diaphragm* discussed in claims 14-16.

As discussed above, there is *no* teaching, suggestion or motivation in the Ngai '628 patent for "illuminating a line surface (3) having a light source (1, 9) designed to have a linearly arranged illumination and having at least one linearly formed optical element (2, 10), wherein in a region of said optical elements (2, 10) of said light source (1, 9) said device comprises at least one diaphragm (6) having a shape which effects a variable numerical aperture along the diaphragm at locations corresponding to a projection of the light through the light through the diaphragm in a direction of the line to decrease a light intensity associated with an imaging lens to substantially reduce vignetting (decrease in light intensity at an end of the line)" as recited in amended claims 1 and 8 of the instant application.

Therefore, Applicant respectfully submits that the Ngai '628 patent does not disclose, teach, or suggest the novel and unobvious features of "illuminating a line surface (3) having a light source (1, 9) designed to have a linearly arranged illumination and having at least one linearly formed optical element (2, 10), wherein in a region of said optical elements (2, 10) of said light source (1, 9) said device comprises at least one diaphragm (6) having a shape which effects a variable numerical aperture along the diaphragm at locations corresponding to a projection of the light through the light through the diaphragm in a direction of the line to decrease a light intensity associated with an imaging lens to substantially reduce vignetting (decrease in light intensity at an end of the line)" as recited in amended claims 1 and 8 of the instant application.

As Applicant has demonstrated above that amended claims 1 and 8 are novel, unobvious and consequently patentable, claims 2-6, 7, 11, and 12-15, and 9, 10 and 16 are also novel, unobvious and consequently patentable over the cited prior art by virtue of their direct or indirect dependency from claims 1 and 8, respectively. No *prima facie* rejection under 35 U.S.C. 103(a) can be made against these claims and Applicant requests an indication of such.

Notwithstanding the above, it is respectfully submitted that the dependent claims also have features which are novel, unobvious and patentable *per se*.

In view of the foregoing, reconsideration and withdrawal of the above rejections is respectfully requested.

CONCLUSION

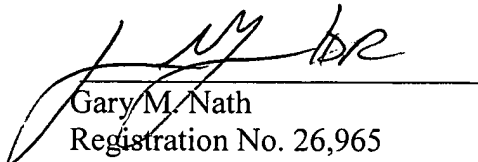
In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner call the undersigned attorney(s).

Respectfully submitted,

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